IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No.	:	09/815,478	Confirmation No.	5342
Appellants	:	Donna B. Dulong et al.		
Filed	:	03/23/2001		
Group Art Unit	:	3626		
Examiner	:	Neal Sereboff		
Title	:	METHOD AND APPARATUS FOR PROVIDING MEDICATION ADMINISTRATION WARNINGS		
Atty. Docket No.	:	CRNI.125945		
Customer No.	:	46169		

VIA EFS-WEB SUBMISSION – 10/16/2008

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

The following is Appellants' Reply Brief to the Examiner's Answer dated August 19, 2008. Having a two-month response date of October 19, 2008, Appellants respectfully submit the following:

I. STATUS OF CLAIMS

Claims 1-51 are pending and rejected, and the rejection of each of claims 1-51 is being appealed.

II. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

A) Claims 1-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,671,563 to Engelson et al. ("Engelson") in view of U.S. Patent No. 6,529,892 to Lambert ("Lambert").

Appellants respectfully traverse the rejection of these claims.

III. ARGUMENT

Appellants respectfully submit that all previously presented arguments as set forth in the Appeal Brief dated June 16, 2008 are considered relevant to this Appeal. The absence herein of any argument from those papers is not intended to convey concession on a particular ground of the Appeal. The following remarks are submitted in addition to those papers and in reply to the arguments conveyed in the Examiner's Answer dated August 19, 2008.

A) Claims 1-17

1) The Examiner has erred by failing to properly determine the scope and contents of the prior art and the differences between the prior art and the claims at issue

In response to Appellants' demonstration of differences between claim 1 and the Engelson reference in Appellants' Appeal Brief, the Examiner's Answer states that "Appellant's argument is directed toward the wrong prior art" since the Lambert reference, not the Engelson reference, is used for a feature of claim 1. *Examiner's Answer*, p. 6-7. This statement demonstrates that the Examiner misunderstands Appellants' arguments and/or has improperly applied the obviousness rejection. While the Examiner has acknowledged that the Engelson reference fails to disclose multiple limitations of the invention of claim 1 and attempted to cure these deficiencies with the Lambert reference (*see, e.g., Office Action dated 12/13/2007*, p. 3-4), the Examiner has not properly applied the obviousness standard set forth by the United States Supreme Court as the Examiner has minimized the extent of the differences between the Engelson reference and claim 1.

As set forth by the United States Supreme Court in *Graham v. John Deere*, 383 U.S. 1 (1966), inquiries as a background for determining obviousness include, *inter alia*, determining the scope and contents of the prior art, and ascertaining the differences between the prior art and the claims at issue. *See, e.g.*, MPEP § 2141. In the present case, the Examiner has not adequately ascertained the differences between the Engelson reference and the invention of claim

1. As discussed in Appellants' Appeal Brief, the approach in Engelson does not involve providing multiple compliance rules for a given medication, each compliance rule having a corresponding condition and medication administration comment such that a medication administration comment for at least one of the compliance rules is provided when a corresponding condition for that compliance rule has been satisfied. Rather, the Engelson reference merely discusses providing discrepancy checking (e.g., whether a scanned medication to be administered corresponds with the patient's record). The approach in the Engelson reference is a less effective one as it merely provides discrepancy checking, while the invention of claim 1 provides multiple compliance rules for a single medication such that different medication administration comments may be provided based on different conditions that may be present when the medication is to be administered. These are significant differences between claim 1 and the Engelson reference. Thus, Appellants' claimed invention advances the state of the art beyond what is taught in the Engelson reference.

The Examiner's Answer also states that Appellants' argument includes "possible intended uses of his invention." Appellants respectfully submit that the arguments are not merely "possible intended uses" as suggested by the Examiner but, instead, illustrate concrete differences between the invention recited by claim 1 and what is disclosed by the Engelson reference. Again, Appellants submit that these are significant differences, and it would not have been obvious to one skilled in the art at the time of the invention of claim 1 to have modified the Engelson reference to achieve the invention of claim 1. The Examiner is improperly minimizing the extent of the differences between claim 1 and the Engelson reference, and as a result, has not properly applied the obviousness standard set forth by the United States Supreme Court in *Graham v. John Deere*.

2) The Examiner has erred by improperly dissecting claim 1 and evaluating the elements in isolation

In response to Appellants' demonstration of the shortcomings of the Lambert reference to cure the deficiencies of the Engelson reference in Appellants' Appeal Brief, the Examiner's answer states that "the claim language is different than the Appellant's remarks" by referring to a single element of claim 1. *Examiner's Answer*, p. 7. In doing so, the Examiner is improperly dissecting claim 1 and divorcing limitations of the element from one another. "[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." MPEP § 2106. When claim 1 is viewed as a whole, the claimed language directly corresponds with Appellants' remarks in the Appeal Brief. The Examiner's statement appears to be focusing on a single element of claim 1 while ignoring the remainder of the claim. Moreover, the Examiner has failed to demonstrate how Appellants' remarks in the Appeal brief differ from the recitations of claim 1.

3) The Examiner has erred by ignoring recitations of claim 1 that define "medication administration comments"

The Examiner's Answer states that "the 'medication administration comments' are not defined within the originally filed Specification and so are broadly understood to be a field containing additional information about the medical condition." Appellants respectfully submit that the Examiner has ignored recitations of claim 1 that define "medication administration comments" in an attempt to find the Lambert reference as relevant art. In particular, claim 1 specifically recites that the medication administration comments are "for preventing medication administration errors," and "are provided at a place of administration of a medication in a hospital setting." As explained in Appellants' Appeal Brief, the Lambert reference is silent with respect to medication administration comments that are for preventing medication administration

errors and that are provided at a place of administration of a medication in a hospital setting. Instead, the Lambert reference discusses determining the likelihood and, in some cases, the severity of confusion between two drug products. There is no indication that the information determined in Lambert is ever provided at the time of administration of a medication in a hospital setting to prevent medication administration errors.

Additionally, Appellants respectfully submit that the Examiner's position ignores other portions of claim 1. Claim 1 does not recite "medication administration comments" in isolation. Instead, claim 1 specifically recites multiple compliance rules for a given medication, and each compliance rule includes a medication administration comment and a condition that, when satisfied, causes the medication administration comment to be displayed at a place of administration of the medication. The Lambert reference does not teach or suggest any compliance rule that includes both a medication administration comment and condition such that when the condition is satisfied for the compliance rule, the corresponding medication administration comment is provided.

B) Claims 18-34

The Examiner's Answer "responds to the arguments for claims 18-34 as above," referring to the responses to claims 1-17. *Examiner's Answer*, p. 8. Initially, Appellants respectfully submit that the arguments provided hereinabove for claims 1-17 are equally applicable to claims 18-34. Additionally, Appellants note the Examiner's Answer fails to address that independent claim 18 recites language that differs from that which is recited in claim 1.

C) Claims 35-51

The Examiner's Answer "responds to the arguments for claims 35-51 as above," referring to the responses to claims 1-17. *Examiner's Answer*, p. 8. Initially, Appellants respectfully submit that the arguments provided hereinabove for claims 1-17 are equally applicable to claims

35-51. Additionally, Appellants note the Examiner's Answer fails to address that independent claim 35 recites language that differs from that which is recited in claim 1.

D) Conclusion

Because claims 1-51 are patentable over the Engelson and Lambert references for at least the reasons cited hereinabove, Appellants respectfully request that the rejection of the claims be reversed and the claims allowed.

It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/John S. Golian/

John S. Golian
Reg. No. 54,702

SHOOK, HARDY, & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
Tel.: 816/474-6550